

## **REMARKS**

### **I. Introduction**

This is in response to the Office Action dated May 19, 2004. The Office Action first rejected claims 9 and 16 under 35 U.S. C. 112, second paragraph, as having claim terms lacking antecedent basis. The Office Action next rejected claims 9, 11, 13, 14 and 16-20 under 35 U.S.C 102(e) as being anticipated by Heinonen et al. (U.S. Patent No. 6,671,370) (“Heinonen”). The Office Action next rejected claim 1 under 35 U.S.C. 103(a) as being unpatentable over Peterson et al. (U.S. Patent No. 6,385,303) (“Peterson”) in view of Heinonen. The Office Action also rejected claims 2 and 8 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Hainonen and further in view of Murakami et al. (U.S. Pub. No. 2001/0011293) (“Murakami”). The Office Action further rejected claims 3-5 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Heinonen and further in view of Epler et al. (U.S. Patent No. 6,026,156) (“Epler”). The Office Action also rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Heinonen further in view of Walker et al. (U.S. Patent No. 6,397,184) (“Walker”). The Office Action also rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Heinonen further in view of Meffert et al. (U.S. Pub. No. 2002/0059144) (“Meffert”). The Office Action also rejected claim 10 under 35 U.S.C. 103(a) as being unpatentable over Heinonen in view of Meffert. The Office Action also rejected claims 12 and 15 under 35 U.S.C. 103(a) as being unpatentable over Heinonen in view of Reformato et al. (U.S. Patent No. 6,229,880) (“Reformato”).

Applicants have canceled claim 14 and have rewritten that claim in independent format as new claim 21. Applicants have amended claims 9 and 16 in response to the 35 U.S.C. 112 rejection. Applications have also amended claims 11 and 19 to correct typographical errors in those claims. Applicants respectfully traverse all rejections over cited art. Claims 1-13 and 15-21 remain under consideration.

## II. 35 U.S.C. 112 Rejections

The Office Action first rejected claims 9 and 16 under 35 U.S.C. 112, second paragraph, as having claim terms lacking antecedent basis. In response to this rejection, applicants have amended claim 9 to modify the phrase “the other users” to “other users” and “the one” to “one.” Applicants have also amended claim 16 to modify the phrase “the selecting user” to “a selecting user.” Accordingly, the rejection under 35 U.S.C. 112 has been overcome. Applicants respectfully request that this rejection be removed.

## III. The Pending Claims are Patentable Over the Cited Art

### A. 35 U.S.C 102(e) Rejection: Heinonen

The Office Action next rejected claims 9, 11, 13, 14 and 16-20 under 35 U.S.C 102(e) as being anticipated by Heinonen. Claim 14 has been canceled and has been rewritten in independent format as new claim 21. Accordingly, the rejection of claim 14 will be treated as applying to new claim 21. Claims 11 and 19 have been amended to correct typographical errors in those claims. In order for a claim to be anticipated under 35 U.S.C. 102, each and every limitation of the claim must be found either expressly or inherently in a single prior art reference. PIN/NIP, Inc. v. Platte Chem. Co., 304 F.3d 1235, 1243 (Fed. Cir. 2002). In the present case, Heinonen does not show each and every limitation of claims 9, 11, 13, 14 and 16-20. Therefore, Applicants request the withdrawal of the rejection under 35 U.S.C. 102(e).

The present invention is generally directed to methods for identifying users over a network using a unique audible signature, personal sound identifier, or sound ID, which refer to one or more short or abbreviated sound snippets or a selection of notes, tunes, themes, or melodies which identifies one user to other users. Heinonen is directed to a telephone system and method whereby a calling user can select from a plurality of ringing indications, including sound information and/or visual information. According to Heinonen, these ringing indications are useful to identify the calling user to the recipient or to identify the priority of the call. For the reasons discussed below, Heinonen does not anticipate the presently claimed invention under the strict §102 standard as set forth above.

Independent claim 9 is directed to a method for facilitating the identification of users in a network. According to claim 9, a plurality of audible signature selections from a plurality of users in the network is received, each user selecting a unique audible signature to identify themselves to other users in the network. Then, communications are distributed between the plurality of users in the network with each communication accompanied by the unique audible signature of the user which initiated the communication so as to identify that user to one or more users who receive the communication. In concluding claim 9 is anticipated by Heinonen, the Office Action cites the abstract, figures 2 and 3, and column 3, lines 13-29 of Heinonen as teaching “each user selecting a unique ringing indication to identify themselves to the other users in the network.” The Office Action further cites these same passages, as well as column 9, line 61 – column 10, line 6 as teaching “each communication is accompanied by the unique call ringing indication of the user.

Figures 2 and 3 of Heinonen show a general system and steps of a method, respectively, of how a ringing indication can generally be selected from a data file by a calling user. Column 3, lines 13-29 of Heinonen teaches “a calling user . . . pre-select(s) ringing information in the form of a ringing indication from a data file whose sound information/visual information is preferably known to all of, or at least some of, the telephone terminal users within the telephone system” and further teaches that “a call header . . . operates to set the receiving telephone terminal to receive the ringing information.” Column 9, line 61 – column 10, line 6 teaches that a calling user may append a tag or a sign indicative, for example, of the type of call being made, and that “at least some of the (receiving) system users have loaded a data file in order to identify what type of ringing indication they wish to have activated at their telephone terminal” in response the call from the calling user. None of these cited portions of Heinonen, however, teach that the ringing indication is “unique” to a particular user, as claimed in claim 9. In fact, nothing in Heinonen would prevent more than one user from selecting the same ringing indication. Thus, if two callers selected the same ringing indication (and thus the ringing indication was not unique), calls to the same recipient would be indistinguishable from each other when received by the recipient. For this reason,

Heinonen fails to teach each and every limitation of claim 9 and, therefore, claim 9 is not anticipated by Heinonen.

It follows that claims 10 -13 and 15 are allowable as being dependent upon an allowable base claim. In addition, the dependent claims add additional patentable subject matter and are allowable for the additional reasons discussed below.

Claim 11 is directed to the method of claim 9 wherein “the user receiving the message is played the audible signature of the user which initiated the communication followed by the playing of the actual communication.” The Office once again cites figures 2 and 3, column 3, lines 13-29 as well as column 9, lines 13-20 as teaching this element. However, figures 2 and 3 and column 3, lines 13-29 teach only that which is discussed above. Column 9, lines 13-20 of Heinonen merely teaches a method whereby a calling user selects a ringing indication and that an incoming call at a receiving user is signaled by playing the ringing indication. Contrary to that which is asserted by the Office, these passages do not teach playing an audible signature of a user followed by the playing of the actual communication. At most, these passages of Heinonen imply that, upon receiving a ringing indication from a calling user, a receiving user can choose to initiate a communication (i.e., a telephone call) with the calling user. Therefore, Heinonen fails to teach each and every element of claim 11 and, therefore, claim 11 is not anticipated by Heinonen. As a result, claim 11 is allowable for this additional reason.

Claim 14 has been canceled and rewritten in independent format as new claim 21. Accordingly, the rejection of claim 14 will be treated herein as applied to new independent claim 21. Claim 21 is directed to a method as taught in claim 9, further comprising “providing a selection of audible signatures for selection by the plurality of users. . . wherein “two or more users are prevented from selecting the same audible signature.” The Office cites figures 2, 3 and column 3, lines 13-29 of Heinonen as teaching the latter element. However, once again, these cited sections only teach that which is recited above in association with the discussion of claim 9. These sections do not teach preventing users from selecting the same audible signature as claimed in claim 21. Therefore, Heinonen fails to teach each and every element of claim 21 and, as a result, claim 21 is not anticipated by Heinonen. As a result, claim 21 is allowable for this additional reason.

Independent claim 16 also contains the limitation that “the ringing indications uniquely identify the selecting user to others in the communications network.” Accordingly, claim 16 is allowable for the same reasons as discussed above in association with claim 9.

Therefore, it follows that claims 17 – 20 are allowable as being dependent upon an allowable base claim. In addition, the dependent claims add additional patentable subject matter and are allowable for the additional reasons discussed below.

Claim 17 is directed to the method of claim 16 wherein a selection facility “comprises a plurality of audible sound identifiers organized into categories.” The Office cites figures 2 and 3; column 3, lines 13-29; column 5, line 64-column 6, line 8; and column 9, line 61 – column 10, line 6 of Heinonen as anticipating this element of claim 17. Once again, figures 2 and 3; column 3, lines 13-29; and column 9, line 61 – column 10, line 6 only teach that which is discussed above in association with claim 9. Column 5, line 64 – column 6, line 8 of Heinonen teaches a plurality of telephone systems or LANs that “are physically located to service (a plurality of) commercial organizations” and that each commercial organization has a plurality of telephone handsets. This passage further teaches that “each handset within a LAN system is located in a different user office of a given commercial organization or establishment.” These cited passages of Heinonen do not teach “a plurality of audible sound identifiers organized into categories” nor do they teach a selection facility comprising such categorized audible sound identifiers. Therefore, Heinonen fails to teach each and every element of claim 17 and, therefore, claim 17 is not anticipated by Heinonen. As a result, claim 17 is allowable for this additional reason.

Claim 18 is directed to the method of claim 16 wherein users are allowed to create their own audible sound identifiers for inclusion in the selection facility. The Office cites the abstract and column 6, lines 17-27 as teaching this element of claim 18. That portion of Heinonen, however, teaches that a ringing indication can be selected by the calling user from a predefined set of indications as a call is being placed or the indication can be selected by the receiving user in accordance with the type of the call. This passage of Heinonen does not teach a user creating their own audible sound identifiers for inclusion in the selection facility. Therefore, Heinonen fails to teach each and every element of

claim 18 and, as a result, claim 18 is not anticipated by Heinonen. As a result, claim 18 is allowable for this additional reason.

Claim 19 is directed to the method of claim 16 wherein the audible sound identifiers are not re-played for a user during repetitive communications between the users. Claim 19 has been amended to replace the phrase “user” with “the receiving user” to correct a typographical error. Support for this term is found in claim 16. The Office cites figures 2 and 3; column 3, lines 13-29; and column 9, line 61 – column 10, line 6 of Heinonen as anticipating this element of claim 19. Once again, these passages only teach that which is discussed above in association with claim 9. These passages do not teach ringing indications that are not replayed for a user during repetitive communications between the users. Therefore, Heinonen fails to teach each and every element of claim 19 and, therefore, claim 19 is not anticipated by Heinonen. As a result, claim 19 is allowable for this additional reason.

Thus, for the foregoing reasons, claims 9, 11, 13 and 16-21 are not anticipated by Heinonen. Applicants respectfully request that the rejection of those claims under 35 U.S.C 102(e) be withdrawn and that those claims be allowed.

B. 35 U.S.C. 103(a) Rejection: Peterson in view of Heinonen

The Office Action next rejects claim 1 as being obvious over Peterson in view of Heinonen. In order for an invention to be obvious under 35 U.S.C. 103(a), there must be some suggestion to combine or modify cited prior art references in a manner that would show or suggest the claimed invention. In the present case, neither Peterson nor Heinonen, either alone or in combination, show or suggest the claimed invention of claim 1. Therefore, Applicants request the withdrawal of the rejection of claim 1 under 35 U.S.C. 103(a).

Peterson teaches a system and method for identifying and announcing a caller and a callee of an incoming telephone call. According to Peterson, after a telephone system receives a telephone call from a caller, the telephone system answers the incoming telephone call and prompts the caller to say his/her name and, optionally, the name of the recipient of the call. The name of the caller and/or the name of the recipient are then played through a speaker to users of a telephone. The users can then determine whether

or not to enter into a communication session with the caller whereupon voice messages may be exchanged between the users.

Claim 1 is directed to a method for identifying users of a network. In part, claim 1 claims “receiving a message from a first user, the message identifying at least one message recipient.” Claim 1 further teaches that “when the message is provided to . . . (the) recipient” the “sound ID is played for the . . . message recipient upon delivery of the message.” The Office action cites the abstract of Peterson and column 17, lines 9-30 of that same reference as teaching this element. However, as discussed above, Peterson does not teach receiving a message from a first user as contemplated by the present application. Nor does Peterson teach playing a sound ID upon delivery of the message. Instead, Peterson only teaches playing back user identification information and optionally recipient identification information. Only after this user/recipient identification is played can a communication session be initiated (i.e., a telephone call in Peterson). Heinonen also does not teach this element. As discussed above in association with the 102(e) rejection, Heinonen only teaches receiving messages that identify the caller, not the message recipient. Therefore, neither Heinonen nor Peterson, separately or in combination, teaches or suggests the element of claim 1 of “when the message is provided to . . . (the) recipient” the “sound ID is played for the . . . message recipient upon delivery of the message.” Since there is no teaching or suggestion of all elements of claim 1, this rejection is improper and claim 1 is allowable. Therefore, Applicants respectfully request the withdrawal of the rejection of claim 1 under 35 U.S.C. 103(a) and that claim 1 be allowed. It follows that claims 2-8 are allowable as being dependent upon an allowable base claim.

C. 35 U.S.C. 103(a) Rejection: Peterson in view of Hainonen further in view of Murakami

The Office Action next rejects claims 2 and 8 as being obvious over Peterson in view of Heinonen, further in view of Murakami. Neither Peterson, Heinonen nor Murakami, alone or in combination, show or suggest the claimed invention of claims 2 and 8. Therefore, Applicants request the withdrawal of the rejection of claims 2 and 8 under 35 U.S.C. 103(a).

Murakami teaches generally a chat system terminal device and display method. According to Murakami, conversations by characters in channels are displayed in individual regions on one display screen. Claim 8 of the present application teaches the method of claim 1 wherein “providing the message comprises playing the first user’s sound ID followed by the message.” The Office cites Peterson column 4, lines 52-62 and column 17, lines 9-30 as teaching this element of claim 8. However, each of these passages of Peterson, only teaches playing a self-identification indication and then, upon a user answering a call in response to this self-identification, connecting a telephone call. Alternatively, if the telephone call is not connected, the caller may be forwarded to an answering machine. These sections of Peterson do not teach playing a sound ID followed by a message, as claimed in claim 8. Additionally, neither Heinonen nor Murakami teach this element or suggest any modification to any reference to teach this element. Therefore, since there is no teaching or suggestion of all elements of claim 8, this rejection is improper and claim 8 is allowable for this additional reason.

D. 35 U.S.C. 103(a) Rejection: Peterson in view of Heinonen further in view of Epler

The Office Action next rejects claims 3-5 as being obvious over Peterson in view of Heinonen, further in view of Epler. Dependent claim 3 contains limitations directed to the message or communication being an activity status message or update. The Office Action admits that neither Heinonen nor Peterson disclose an activity status message or an activity status update. In rejecting claim 3, the Office Action relies on Epler as disclosing distinctive ringing and indicates that distinctive ringing is a disclosure of an activity status update. As set forth in the cited portion of Epler, distinctive ringing allows a user to have multiple telephone numbers associated with a given line and the telephone(s) connected to the line ring distinctively depending upon the number called. Distinctive ringing does not indicate the activity status of a user that sent a message to the receiving device. Therefore, Epler does not provide the missing disclosure. Accordingly, claim 3 is not obvious over the combination of Peterson in view of Heinonen, further in view of Epler and, therefore, that claim 3 is allowable for this additional reason. It



follows that dependent claims 4 and 5 are therefore also allowable as being dependent upon an allowable base claim.

Claim 5 adds the limitation that the activity alert sound alerts the message recipient that the first user has become active on a device. The Office Action cites the pre-announcement of Peterson at column, 4, lines 52-62, column 6, lines 32-45 and column 17, lines 9-30 as teaching this element of claim 5. As discussed above, each of these sections only teaches playing a pre-announcement (i.e., a self-identification indication) and then, upon a user answering a call in response to this self-identification, connecting a telephone call. With respect to claim 5, it is noted that the pre-announcement of Peterson indicates the identity of a caller calling a recipient. It does not, as required by claim 5, alert the subscriber that the caller has become active on a device. For example, the caller may become active long before calling the subscriber, and in accordance with Peterson, the recipient would not be notified of the caller becoming active. The subscriber is only notified when the caller calls the recipient. Therefore, Peterson does not teach nor does it suggest the necessary element of claim 5 that the activity alert sound alerts the message recipient that the first user has become active on a device. Additionally, neither Heinonen nor Epler teach or suggest this element. For this reason, this element of claim 5 is not obvious over Peterson, Heinonen or Epler, either individually or in combination. Therefore, claim 5 is allowable for this additional reason.

E. 35 U.S.C. 103(a) Rejection: Peterson in view of Heinonen further in view of Walker

The Office Action next rejects 6 as being obvious over Peterson in view of Heinonen, further in view of Walker. Claim 6 further limits the sound ID of claim 1 to being a “snippet of notes.” The Office Action admits that Peterson and Heinonen fail to disclose this limitation. The Office Action relies on Walker as supplying the missing disclosure. Walker is an invention in the photographic art and is directed to associating audio descriptions with photographs. As discussed in a previously-filed response in this application, yet to be addressed by the Office, the photography art is non-analogous to the network communications art. As such, it is improper to rely on Walker as a reference.

The Court of Appeals for the Federal Circuit has addressed the issue of non-analogous art and has set forth the standard that, in order to rely on a reference as a basis for rejection of an invention, the reference must either be in the field of the invention's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Common sense must be used in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. Id. The combination of elements from nonanalogous sources, in a manner that reconstructs the invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. Id. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. Id. That knowledge cannot come from the Applicant's invention itself. Id.

In the present case, it is clear that an inventor working in the area of network communications would not reasonably be expected to look for a solution to a problem in the photographic arts. The motivation to search the patent database for the terms "snippet of notes" would only occur after having knowledge of the claimed invention of claim 6 and using impermissible hindsight. An inventor, working on the problem of data network communications, would not have any motivation to look to the photographic arts for a solution. As such, the reliance on Walker is impermissible. For these additional reasons, claim 6 is allowable.

F. 35 U.S.C. 103(a) Rejection: Peterson in view of Heinonen further in view of Meffert

The Office Action next rejects claim 7 as being obvious over Peterson in view of Heinonen, further in view of Meffert. Claim 7 further limits the sound ID of claim 1 to being a "at least a portion of a popular song". The Office Action relies on Meffert as supplying the missing disclosure. Meffert is an invention directed to secure content delivery using encryption. For reasons similar to those described above in connection with the Walker reference, and as also presented in a previous response filed in this application (also unaddressed by the Office), Meffert is in a different field of endeavor and there would be no motivation of one skilled in the art to look to the

encryption/content delivery art for a solution to a network communication problem. Further, even if Meffert was considered to be in an analogous art, there is no motivation, except with impermissible hindsight, to combine Meffert with either Peterson or Heinonen. The Office Action states that Meffert “teaches that the sound ID is at least a portion of a popular song”. However, this is an incorrect characterization of Meffert. The cited portion of Meffert teaches encrypting songs, or trial portions of songs, for secure content delivery. This is very different from using a portion of a song as a sound ID in accordance with claim 7. Thus, claim 7 is allowable over the cited art for this additional reason.

G. 35 U.S.C. 103(a) Rejection: Heinonen in view of Meffert

Claim 10 contains the limitation that the “audible signature is a portion of a song”. The Office Action rejected claim 10 in reliance on Meffert as teaching this element. Neither Heinonen nor Meffert teach this element and, therefore, Claim 10 is allowable for the same reasons as discussed above in connection with claim 7.

H. 35 U.S.C. 103(a) Rejection: Heinonen in view of Reformato

The Office Action next rejects claims 12 and 15 as being obvious over Heinonen in view of Reformato. In rejecting claim 12, the Office Action admits Heinonen fails to teach “activity status update” and cites Reformato as disclosing the missing disclosure. The cited portion of Reformato discloses updating a database to reflect changes in the status information associated with a subscriber. However, claim 12 is directed to a “communication” or “message” which indicates an activity status. Reformato does not disclose such a communication or message to other users and therefore does not provide the missing disclosure. Therefore, in addition to being allowable as being dependent upon allowable claim 9, claim 12 is allowable for this additional reason.


Claim 15 teaches, in part, the method of claim 13 where the audible signature is preceded by an activity signal. Once again the Office Action relies on Reformato as disclosing this element. However, for the same reasons discussed in association with claim 12 above, Reformato does not disclose a communication or message which

indicates an activity status to other users. Therefore, Reformato does not provide the missing disclosure. Accordingly, claim 15 is allowable for this additional reason.

#### IV. Conclusion

For the reasons discussed above, claims 1-13 and 15-21 are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David W. Herring", written over a horizontal line.

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